

(d) Comments

A. The Examiner has not established a *prima facie* case of anticipation regarding new claim 14, which replaces original claim 1.

The Commissioner (through the Examiner) bears the initial duty of supplying the
5 factual basis supporting a rejection of a patent application, including a rejection based on
anticipation. *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967), *cert.*
denied, 389 U.S. 1057 (1968). *See also In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443,
1447 (Fed. Cir. 1992) (Plager, J., concurring) ("It is the Commissioner's duty (acting
through the examining officials) to determine that all requirements of the Patent Act are
10 met.").

As further stated by the CCPA: "We think the precise language of 35 U.S.C. 102
that "a person shall be entitled to a patent unless * * *," concerning novelty and
unobviousness, clearly places a burden of proof on the Patent Office which requires it to
produce the factual basis for its rejection of an application under sections 102 and 103 .

15 The courts have interpreted this initial duty as placing on the Commissioner and
the Examiner the burden of presenting a *prima facie* case of anticipation. *See in re King*,
801 F.2d 1324, 1327231 USPQ 136, 138-39 (Fed. Cir. 1986); *in re Wilder*, 429 F.2d 447,
450, 166 USPQ 545,548 (CCPA 1970).

In *WL Gore & Associates v. Garlock, Inc.*, (W.L. Gore & Assocs. v. Garlock, 721
20 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). the
Federal Circuit stated that "[a]nticipation requires the disclosure in a single prior art
reference of each element of the claim under consideration." *Id.*, 220 USPQ at 313
(citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct.

Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)).' It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*."

- 5 108Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

In the instant case, the independent claims 27 and 28 contain, in the preambles, the limitations that the steps claimed in the methods are "software-implemented steps".

- 10 Claim 27 contains, *inter alia*, the following steps:

"(iii) creating Linking Information between said Drawing Entity and said text;"

"(v) associating all linking information with the corresponding Drawing Entity;"

- 15 and

"(vi) storing each Drawing Entity, and corresponding text, together with the associated linking information;"

- In contrast, *Rossberg* uses a purely manual method of associating Keynotes, which *Rossberg* uses as a manual analog of the links of the present patent, to identify the corresponding text, which may be stored either manually, or by software means. In either case, however, *Rossberg* does not use computer software means to associate the keynotes with the text, but requires manually browsing the keynotes to find the associated text.
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More important, however, is the fact that in the present invention the text created which corresponds to the drawing entity is stored for future use See step (vi) above.

Rossberg does not contains this step, nor any equivalent step.

- Likewise, claim 28 of the present invention contains the same steps using
- 5 somewhat different language as follows:
- (b) for each drawing entity, determining whether a corresponding notes record exists in the notes database;
 - (c) if not, providing an editing process from which the user can edit the Master Specification Document, thereby producing a new notes record in the notes database
 - 10 which corresponds to the current drawing entity;
 - (d) adding the contents of the corresponding notes record into a Project Specification Database corresponding to the current project;
 - (e) adding the contents of the corresponding notes record into the notes database;

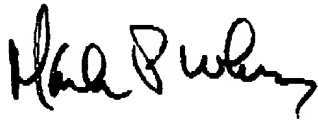
- In the above steps, the "notes database" contains the text which corresponds to the
- 15 drawing entities, and which is progressively created in the current project, and also used by subsequent projects. In contrast, *Rossberg* is a manual system, as previously stated. *Rossberg* further requires that in each project the user must use the Keynote reference number to manually identify the area of the Master Specification Document which contains the appropriate text. The user must then extract the from the Master
- 20 Specification Document anew, regardless of how many times this process was performed in the past.

Inasmuch as the Examiner has not established such a *prima facie* case of anticipation, the Applicant is entitled to the grant of a patent on claim 14, and on all claims dependent of claim 14. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443.

The applicant has traversed all the other objections and rejections of the Examiner
5 by amending paragraphs in the Specification above, and by providing replacement sheets for drawings nos. 4, 6, and 7.

It is believed that the amendment made herein, and the arguments propounded
above, effectively traverse the Examiner's objections, and put this Application in
condition for allowance, which is hereby requested.

10 Respectfully submitted, on June 2, 2003, by



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